

REMARKS

Claims 26, 28, and 30 have been canceled. No claims are amended or added. Hence, Claims 1-13, 15-19, 23, 24, 27, and 31 are pending.

I. ISSUES RELATED TO CITED REFERENCES

A. 35 USC 102(e) – *PHILLIPS*

Claims 1-3, 5, 7-11, 13, 23, 24, and 26-28 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Phillips et al., U.S. Patent No. 6,615,189 (hereinafter "*Phillips*"). The rejection to Claims 26 and 28 is moot as these claims have been canceled. The rejection to each of Claims 1-3, 5, 7-11, 13, 23, 24, and 27 is respectfully traversed hereinafter.

Independent Claim 1

Claim 1 is directed to a method of processing an electronic stored value certificate. Claim 1 recites issuing the electronic stored value certificate from a certificate issuer in response to successfully carrying out a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account **associated with a merchant**. Claim 1 also recites determining a new face value by reducing the initial face value of the electronic stored value certificate by a portion of the initial face value in response to receiving information indicating **redemption at the merchant** of the portion of the initial face value for goods or services. Claim 1 further recites that **the unique identification value is a random value that is non-negotiable in a commercial credit card network** and that **the unique identification value is operable for redemption of the electronic stored value certificate at the merchant by communication of the merchant with the certificate issuer in a redemption transaction that does not traverse the commercial credit card network**. Claim 1 also recites **displaying the new face value of the electronic stored value certificate to the recipient**. At least these features of Claim 1 are not disclosed in *Phillips*.

The Office Action argues that *Phillips* in “abstract; FIG. 1 and associated text; col. 3 line 41 to col. 4 line 45 explicitly and/or implicitly” discloses issuing the electronic stored value certificate from a certificate issuer in response to successfully carrying out a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account **associated with a merchant**. This is a mischaracterization of *Phillips*. *Phillips* describes a method in which an offeror such as a credit card issuer may issue a purchase card to a customer (*see* col. 3 lines 1-3). Specifically, *Phillips* at col. 3 lines 39-47 discloses that a transaction may be posted to a purchaser’s **credit card**. In the same passage, *Phillips* states that, in another embodiment, a purchaser may use check, cash, or other financial methods to obtain a purchase card. Clearly, the Office Action’s argument that *Phillips* discloses a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account **associated with a merchant** is not substantiated by the evidence.

The Office Action also argues that *Phillips* in “abstract; FIG. 1 and associated text; col. 3 line 41 to col. 4 line 45 explicitly and/or implicitly” discloses determining a new face value by reducing the initial face value of the electronic stored value certificate by a portion of the initial face value in response to receiving information indicating **redemption at the merchant** of the portion of the initial face value for goods or services. This is also a mischaracterization of *Phillips*. *Phillips* emphasizes that a recipient of the purchase card may use the purchase card to make purchases “**wherever**, for example, VISA® cards are accepted” (*see* col. 4 lines 48-50). Thus, in *Phillips*, the purchase card is usable at any of several merchants -- even at a merchant without having been successfully transferred value in “a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account associated with [the] merchant”, as recited in Claim 1. *Phillips* specifically

teaches away from an approach in which electronic stored value certificate, issued after a transfer of funds to an account of a merchant, is redeemed at the same merchant that has received the transferred value as claimed. *See* col. 1 lines 25-29.

The Office Action further argues that *Phillips* in “col. 3 lines 58-67 and col. 4 [sic] lines 2-5” discloses that **the unique identification value is a random value that is non-negotiable in a commercial credit card network** and that **the unique identification value is operable for redemption of the electronic stored value certificate at the merchant by communication of the merchant with the certificate issuer in a redemption transaction that does not traverse the commercial credit card network**. This is a further mischaracterization of *Phillips* in light of the disclosure in *Phillips*. *Phillips* emphasizes that a recipient of the purchase card may use the purchase card to make purchases “**wherever**, for example, VISA® cards are accepted” (*see* col. 4 lines 48-50). Thus, at least some of the time the purchase card of *Phillips* is negotiable in a VISA® card network, which is a commercial credit card network, in sharp contrast to the features of Claim 1 in which the certificate is never negotiable in a credit card network.

Moreover, in all described scenarios of using the purchase card, *Phillips* discloses that the purchase card is used **wherever** (the phrase “for example” in *Phillips* does not contradict or negate in any way the term “wherever”) a credit card is used. The Office Action insists that the mention of a third party processor in *Phillips* “suggest a non-credit card entity.” The Office Action apparently contends that the passage at col. 3 lines 58-60 provides evidence in support of the allegation that *Phillips* discloses that **the unique identification value is a random value that is non-negotiable in a commercial credit card network** and that **the unique identification value is operable for redemption of the electronic stored value certificate at the merchant by communication of the merchant with the certificate issuer in a redemption transaction that does not traverse the commercial credit card network**. This is incorrect.

The passage at col. 3 lines 58-60 only discloses that a third party processor may perform **establishing or managing** an account for the purchase card. In particular, the passage never suggests that the purchase card is used in a redemption transaction that does not traverse the commercial credit card network. The mere fact that a third party processor may perform **establishing or managing** an account for the purchase card does not mean that **the unique identification value is a random value that is non-negotiable in a commercial credit card network** and that **the unique identification value is operable for redemption of the electronic stored value certificate at the merchant by communication of the merchant with the certificate issuer in a redemption transaction that does not traverse the commercial credit card network.**

The Office Action also argues that *Phillips* in “col. 4 lines 46-57; col. 5 lines 1-5; col. 2 lines 57-59” discloses **displaying the new face value of the electronic stored value certificate to the recipient.** Applicant has studied these citations and elsewhere in *Phillips* in great detail and found no express or implicit disclosure in *Phillips* that a new face value of the electronic stored value certificate to the recipient is displayed. The card of *Phillips* has no display capability and is not itself depicted on a screen or display. Clarification is respectfully requested.

For the reasons given above, Claim 1 is patentable over *Phillips*.

Claim 2

Claim 2 depends from Claim 1 and is patentable for the same reasons discussed above with respect to Claim 1. Claim 2 further recites:

generating information defining a graphic image, **in the form of a gift certificate, promotion certificate, incentive certificate, or award certificate**, and that contains the certificate information, for display by a client computer associated with the recipient.

(Emphasis added)

At least these above-recited features of Claim 2 are not disclosed in *Phillips*. The Office Action only generally states that Claim 2 has been rejected but provides no specific reason in rejecting Claim 2 in view of these further recited features. An omnibus rejection of the claim "on the references and for the reasons of record" is not informative, provides no basis for review by the appeal board or a court, and should therefore be avoided. *See* MPEP 707.07(d). Indeed, a simple statement that Claim 2 has been rejected over *Phillips* fails to satisfy the burden of proof for a prima facie case of unpatentability of the claim. Clarification in a non-final Office Action is respectfully requested.

For these reasons, Claim 2 is patentable over *Phillips*.

Claims 23, 24, and 27

Independent Claims 23, 24, and 27 each recite similar features as those discussed above with respect to Claim 1. Consequently, it is respectfully submitted that Claims 23, 24, and 27 are patentable for at least the same reasons discussed above as to Claim 1.

Claims 2, 3, 5, 7 -11, and 13

Each of dependent Claims 2, 3, 5, 7-11, 13 contains all the features of Claim 1 discussed above and is patentable for the same reasons discussed above with respect to Claim 1. Further, dependent Claims 2, 3, 5, 7-11, 13 contain features that individually render them patentable. Due to the fundamental differences already identified, a separate discussion of those features is not included at this time. For all the foregoing reasons, Applicants respectfully submit that Claims 2, 3, 5, 7-11, 13 are allowable over *Phillips*.

B. 35 USC 103(a) – PHILLIPS AND WALKER

Claim 4 is rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Phillips* in view of Walker et al. US Patent No. 6,138,106 (hereinafter *Walker*). This rejection is respectfully traversed.

Claim 4 contains all the features of Claim 1 discussed above and is patentable for the same reasons discussed above with respect to Claim 1. Further, Claim 4 contains features that individually render it patentable. Due to the fundamental differences already identified, a separate discussion of those features is not included at this time.

For all the foregoing reasons, Applicant respectfully submits that Claim 4 is allowable over *Phillips* in view of *Walker*.

C. 35 USC 103(a) – *PHILLIPS*, LEGAL PRECEDENTS AND/OR OFFICIAL
NOTICE

Claims 6, 12, and 15-19 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Phillips* in view of alleged legal precedents and/or Official Notice. This rejection is respectfully traversed.

Each of dependent Claims 6, 12, and 15-19 contains all the features of Claim 1 discussed above and is patentable for the same reasons discussed above with respect to Claim 1. Further, dependent Claims 6, 12, and 15-19 contain features that individually render them patentable. Due to the fundamental differences already identified, a separate discussion of those features is not included at this time.

The Office Action states that “Applicant’s bald statements demanding support are not adequate and do not shift the burden to the examiner to provide evidence in support of Official Notice”, citing *In re Boon*, 169 USPQ 231 (CCPA 1971). Respectfully, as noted in page 3 of the Office Action, Applicant has challenged the Official Notices and demand support. Applicant has rebutted that, given what the Office Actions have provided, there is no underlying factual basis for the Official Notice taken. Respectfully, pointing out the lack of evidence for the alleged fact is a rebuttal. Therefore, the statement that the Officially Noted Facts are taken as admitted since the challenge is defective is erroneous.

Indeed, an official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). The Office Notices taken by the Office Action have not been supported by documentary evidence. Therefore, the facts asserted in the Official Notices must be not only well-known or common knowledge in the art, but also capable of **instant** and **unquestionable** demonstration as being well-known. In this case, Claim 15 specifically recites redeeming the electronic stored value certificate as tender of all or a portion of payment for goods or services **only when** the recipient selects such goods or services of a specified minimum purchase amount. Claim 16 specifically recites redeeming the electronic stored value certificate as tender of all or a portion of payment for goods or services **only when** the recipient is making the recipient's first purchase of goods or services from a merchant who redeems the certificate. Claim 17 specifically recites redeeming the electronic stored value certificate as tender of all or a portion of payment for goods or services **only for specified selected goods or services**, wherein such specified selected goods or services are determined by a merchant who redeems the certificate. These unusual features in the claims are neither well-known nor common knowledge in commerce, let alone in the context of redeeming an electronic stored value certificate. These recited features are not capable of instant and unquestionable demonstration as being well-known. Therefore, it remains proper to request the Examiner to provide documentary evidence in support of the alleged facts noted in the Official Notices.

For all the foregoing reasons, Applicants respectfully submit that Claims 6, 12, and 15-19 are allowable over *Phillips* in view of alleged legal precedents and/or Official Notice.

D. 35 USC 103(a) – *PHILLIPS* AND LEGAL PRECEDENTS

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Phillips* in view of alleged legal precedents. The rejection to Claim 30 is moot as the claim has been canceled. The rejection to Claim 31 is respectfully traversed.

Independent Claim 31 recites similar features as those discussed above with respect to Claim 1. Consequently, it is respectfully submitted that Claim 31 is patentable for at least the same reasons discussed above as to Claim 1.

II. CONCLUSIONS & MISCELLANEOUS

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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